



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Co et al.
Application No: 09/501,102
Filed: February 9, 2000
For: *Humanized Immunoglobulin Reactive with B7 Molecules and Methods of Treatment Therewith*

Group Art Unit: 1644
Examiner: Phillip Gambel
Docket No.: WYS-004.01

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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December 21, 2005
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By: Shirine Darvish
Shirine Darvish

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This communication is a Response to the Restriction Requirement mailed September 21, 2005. A two-month extension of time is filed currently herewith.

The Examiner has required restriction to one of four groups under 35 U.S.C. § 121 as follows:

Group I: Claims 143-144, drawn to methods of transplanting with an ex vivo method with antibodies, classified in Class 435, 2 and subclass 2.

Group II: Claims 145-154, drawn to a method of treating a transplant recipient with antibodies, classified in Class 424, subclass 173.1.

Group III: Claims 155-157, drawn to a method of decreasing an antibody response to an antigen, classified in Class 424, subclass 130.1.

Group IV: Claim 158-160, drawn to a method of treating an individual having a disease with an antibody, classified in Class 424, subclass 153.1.

Applicants elect, *with traverse*, **Group II** for prosecution on the merits. Applicants' grounds for traversal are set forth below.

The Office Action alleges that Groups I-IV are independent methods of use and require separate searches in the patent and non-patent literature. The Applicants respectfully assert that simultaneous examination of Groups I, II, and IV in particular would not place an undue burden on the Examiner, because the claims of these three allegedly different inventions are directed to methods of use for the combination of immunoglobulins specific to B7-1 and B7-2. A search and examination of methods of transplanting with an ex vivo method comprising use for the combination of immunoglobulins specific to B7-1 and B7-2 would pose no serious burden on the Examiner for search and examination of another method that also comprises use for the combination of immunoglobulins specific to B7-1 and B7-2. Likewise, a search and examination of a method of treating a transplant recipient comprising use of the combination of immunoglobulins specific to B7-1 and B7-2 would also necessarily entail a search and examination of a method comprising use for the combination of immunoglobulins specific to B7-1 and B7-2, also posing no serious burden on the Examiner. See MPEP § 803 ("If the search and examination of an entire application can be made without serious burden, the [E]xaminer must examine it on the merits, even though it includes claims to independent or distinct inventions."). **Therefore, the Applicants respectfully request that the Examiner modify the instant Restriction Requirement, examining Groups I, II, and IV in the instant application.**

In addition to restriction among various groups of claims, the Examiner has further required a species election to a particular drug as embodied by, for example, Groups I, II, and IV, under 35 U.S.C. § 121.

Applicants provisionally elect, *with traverse*, cyclosporin, for search purposes only to the extent that no burden would be required to search other agents, such as immunosuppressive

agents, for example, rapamycin. It is Applicants' understanding that the search will be extended to the remaining species upon a finding of allowability. Applicants request that the Examiner reconsider and withdraw the species election requirement.

Applicants hereby reserve the right to petition the Commissioner to review the restriction requirement if this restriction requirement is made final.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. Should a further extension of time be required, Applicants hereby petition for same. The Commissioner is hereby authorized to charge the extension fee, as well as credit any overpayment or charge any deficiencies to Deposit Account, No. 06-1448; reference WYS-004.01. The Examiner may address any questions raised by this submission to the undersigned at 617-832-1000.

Respectfully submitted,
Foley Hoag LLP

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Dated: December 21, 2005
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